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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,375	11/05/2003	John Colgrave	GB920030002US1	8456
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IBM CORPORATION 3039 CORNWALLIS RD. DEPT. T81 / B503, PO BOX 12195 REASEARCH TRIANGLE PARK, NC 27709			CHEN, QING	
			ART UNIT	PAPER NUMBER
			2191	

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/702,375

Applicant(s)

COLGRAVE, JOHN

Examiner

Qing Chen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is the initial Office action based on the application filed on May 23, 2003. **Claims 1-15** are currently pending and have been considered below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Elements 222, 232, 252, 253, and 255 in Figure 2. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

- The specification contains the following mislabeled drawing elements:
 - Element 205 should be 206 in page 7.

- Element 206 should be 205 in page 7.
- There should be a period (.) after “JavaScript and PerlScript scripts” to mark the end of the sentence in page 10, paragraph {025}. Consequently, the next sentence should begin with “In another embodiment, ...”
- The word “is” should presumably be read “it” after the introductory phrase “In another embodiment,” in page 10, paragraph {025}.

Appropriate correction is required.

4. The use of the trademarks, such as IBM, DB2, SUN, JAVASCRIPT, PYTHON, VBSCRIPT, JSCRIPT, and PERLSCRIPT, has been noted in this application. Trademarks should be capitalized wherever they appear (capitalize each letter OR accompany each trademark with an appropriate designation symbol, e.g., TM or ®) and be accompanied by the generic terminology (use trademarks as adjectives modifying a descriptive noun, e.g., “the JAVASCRIPT scripting language”).

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

5. **Claims 1, 5-7, 10, 11, and 15** are objected to because of the following informalities:
- **Claims 1, 6, and 11** should contain the word “and” at the end of the second limitation.

- **Claims 5, 10, and 15** contain the phrase “at least two from.” It should presumably be read “at least two from the group consisting of.”
- **Claim 7** should contain a period (.) at the end of the limitation body, not a semicolon (;).
- **Claim 11** should contain the word “of” at the end of “comprising the steps” in the preamble.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1, 4, 5, 9-11, 14, and 15** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 11 recite the limitation “the sequence of user requested commands.” There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the Examiner subsequently interprets this limitation as reading “the sequence of commands” for the purpose of further examination.

Claims 4, 9, and 14 recite the limitation “the commands.” There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the Examiner subsequently interprets this limitation as reading “the sequence of commands” for the purpose of further examination.

Claims 5, 10, and 15 contain the trademarks or trade names JAVASCRIPT, PYTHON, VBSCRIPT, JSCRIPT, and PERLSCRIPT. When a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product (in the present case, specific scripting languages) would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 1-15** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of **Claims 1-15** raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment, or machine, which would result in a substantial practical application producing a useful, concrete, and tangible result to form the basis of statutory subject matter under 35 U.S.C. § 101.

The claimed inventions of Claims 1-15 are not tangible embodied, as they do not require the use of hardware to realize the prescribed functionality.

Furthermore, it is noted that Claims 6-10, merely claimed as a scripting tool, contain functional descriptive material, *per se*, and therefore, non-statutory for that reason as well. Also, Claims 11-15 contain functional descriptive material, *per se*, since there is no medium associated with the computer program product either as a claimed element or via an explicit and deliberate definition in the specification that the program product includes the storage medium that permits the function of the descriptive material to be realized, and therefore, non-statutory for that reason as well. The claims constitute computer programs representing computer listings *per se*. Such descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element, which defines structural and functional interrelationships between the computer program and the rest of the computer, that permits the

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computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 1-3, 5-8, 10-13, and 15** are rejected under 35 U.S.C. 102(e) as being anticipated by **Guinart** (US 6,687,897).

As per **Claim 1**, **Guinart** discloses a method for a scripting tool to create a script, the method comprising the steps of:

- A. Receiving a sequence of commands to perform (*see Column 3, Lines 53-55*);
- B. Receiving an indication of one of a plurality of scripting languages (*see Column 6, Lines 60-64; and Column 8, Lines 38-40*); and
- C. Outputting a script in the indicated scripting language, the script containing the sequence of commands (*see Column 8, Lines 41-46*).

As per **Claim 2**, Guinart discloses a method for a scripting tool to create a script **as in Claim 1 above**, and further discloses that the method comprising the step of executing each command in the sequence of commands prior to outputting the script (*see Column 7, Lines 10-24; and Column 8, Lines 18-20 and 36-38*).

As per **Claim 3**, Guinart discloses a method for a scripting tool to create a script **as in Claim 2 above**, and further discloses that the method comprising the step of providing details of the response from the execution of each command to a user (*see Column 8, Lines 16-18 and 24-30*).

As per **Claim 5**, Guinart discloses a method for a scripting tool to create a script **as in Claim 1 above**, and further discloses that the plurality of scripting languages include at least two from the group consisting of JavaScript™, NetRexx, Bean Markup Language (BML), JACL Adventure Creation Language, Jython, Python®, VBScript®, Jscript®, and PerlScript™ (*see Column 1, Lines 49-51*).

As per **Claim 6**, the Applicant appears to be attempting to invoke 35 U.S.C. 112, sixth paragraph, since it contains “means-plus-function” limitations. However, the Examiner notes that the only “means” for performing these recited functions in the specification appears to be computer program modules—software *per se*. While the claim meets the first prong of the three-prong analysis used to determine invocation of 35 U.S.C. 112, sixth paragraph, the claim does not meet the other prongs of the three-prong analysis, since no other specific corresponding

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structure or equivalents thereof are disclosed in the specification. Therefore, the claim limitations are not being treated under 35 U.S.C. 112, sixth paragraph.

Guinart discloses a scripting tool for creating a script, the tool comprising:

A. Means for receiving a sequence of commands to perform (*see Column 3, Lines 53-55*);

B. Means for receiving an indication of one of a plurality of scripting languages (*see Column 6, Lines 60-64; and Column 8, Lines 38-40*); and

C. Means for outputting a script in the indicated scripting language, the script containing the sequence of commands (*see Column 8, Lines 41-46*).

As per **Claim 7**, the Applicant appears to be attempting to invoke 35 U.S.C. 112, sixth paragraph, since it contains a “means-plus-function” limitation. However, the Examiner notes that the only “means” for performing the recited function in the specification appears to be computer program modules—software *per se*. While the claim meets the first prong of the three-prong analysis used to determine invocation of 35 U.S.C. 112, sixth paragraph, the claim does not meet the other prongs of the three-prong analysis, since no other specific corresponding structure or equivalents thereof are disclosed in the specification. Therefore, the claim limitation is not being treated under 35 U.S.C. 112, sixth paragraph.

Guinart discloses a scripting tool for creating a script **as in Claim 6 above**, and further discloses that the scripting tool comprising the means for executing each command in the sequence of commands prior to outputting the script (*see Column 7, Lines 10-24; and Column 8, Lines 18-20 and 36-38*).

As per **Claim 8**, the Applicant appears to be attempting to invoke 35 U.S.C. 112, sixth paragraph, since it contains a “means-plus-function” limitation. However, the Examiner notes that the only “means” for performing the recited function in the specification appears to be computer program modules—software *per se*. While the claim meets the first prong of the three-prong analysis used to determine invocation of 35 U.S.C. 112, sixth paragraph, the claim does not meet the other prongs of the three-prong analysis, since no other specific corresponding structure or equivalents thereof are disclosed in the specification. Therefore, the claim limitation is not being treated under 35 U.S.C. 112, sixth paragraph.

Guinart discloses a scripting tool for creating a script **as in Claim 7 above**, and further discloses that the scripting tool comprising the means for providing details of the response from the execution of each command to a user (*see Column 8, Lines 16-18 and 24-30*).

As per **Claim 10**, Guinart discloses a scripting tool for creating a script **as in Claim 6 above**, and further discloses that the plurality of scripting languages include at least two from the group consisting of JavaScript™, NetRexx, Bean Markup Language (BML), JACL Adventure Creation Language, Jython, Python®, VBScript®, Jscript®, and PerlScript™ (*see Column 1, Lines 49-51*).

As per **Claim 11**, Guinart discloses a computer program product comprising instructions which, when executed on a data processing host, cause the data processing host to carry out a method comprising the steps of:

- A. Receiving a sequence of commands to perform (*see Column 3, Lines 53-55*);
- B. Receiving an indication of one of a plurality of scripting languages (*see Column 6, Lines 60-64; and Column 8, Lines 38-40*); and
- C. Outputting a script in the indicated scripting language, the script containing the sequence of commands (*see Column 8, Lines 41-46*).

As per **Claim 12**, Guinart discloses a computer program product comprising instructions which, when executed on a data processing host, cause the data processing host to carry out a method **as in Claim 11 above**, and further discloses that the method comprising the step of executing each command in the sequence of commands prior to outputting the script (*see Column 7, Lines 10-24; and Column 8, Lines 18-20 and 36-38*).

As per **Claim 13**, Guinart discloses a computer program product comprising instructions which, when executed on a data processing host, cause the data processing host to carry out a method **as in Claim 12 above**, and further discloses that the method comprising the step of providing details of the response from the execution of each command to a user (*see Column 8, Lines 16-18 and 24-30*).

As per **Claim 15**, Guinart discloses a computer program product comprising instructions which, when executed on a data processing host, cause the data processing host to carry out a method **as in Claim 11 above**, and further discloses that the plurality of scripting languages include at least two from the group consisting of JavaScript™, NetRexx, Bean Markup Language

(BML), JACL Adventure Creation Language, Jython, Python®, VBScript®, Jscript®, and PerlScript™ (*see Column 1, Lines 49-51*).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 4, 9, and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Guinart (US 6,687,897)** in view of **Nykanen (US 2002/0174117)**.

As per **Claim 4**, **Guinart** discloses a method for a scripting tool to create a script as in **Claim 1 above**. However, **Guinart** does not explicitly disclose that the sequence of commands is to be executed against a Universal Data Directory Interface (UDDI) registry.

In the same area the problem sought to be solved, **Nykanen** discloses a method to enable a mobile phone or wireless Personal Digital Assistant (PDA) to discover Internet businesses and services by accessing the Universal Description, Discovery, and Integration (UDDI) registry. The method is embodied as programmed instructions, which may be executed within the user's wireless device to query the UDDI registry. Alternately, the method is embodied as programmed instructions, which may be executed within a separate server to query the UDDI registry in response to commands from the user's wireless device (*see Paragraph [0011]*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to execute commands against the UDDI registry in the system of Guinart since Guinart discloses that scripts are used in the Internet (*see Column 1, Lines 56-57*) and scripts are used in many different situations and have a wide range of applications (*see Column 1, Lines 60-61*). One would have been motivated to execute commands against the UDDI registry in order to enable users to quickly, easily, and dynamically find businesses and services on the Internet (*see Paragraph [0004]*).

As per **Claim 9**, Guinart discloses a scripting tool for creating a script **as in Claim 6 above**. However, Guinart does not explicitly disclose that the sequence of commands is to be executed against a Universal Data Directory Interface (UDDI) registry.

In the same area the problem sought to be solved, Nykanen discloses a method to enable a mobile phone or wireless Personal Digital Assistant (PDA) to discover Internet businesses and services by accessing the Universal Description, Discovery, and Integration (UDDI) registry. The method is embodied as programmed instructions, which may be executed within the user's wireless device to query the UDDI registry. Alternately, the method is embodied as programmed instructions, which may be executed within a separate server to query the UDDI registry in response to commands from the user's wireless device (*see Paragraph [0011]*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to execute commands against the UDDI registry in the system of Guinart since Guinart discloses that scripts are used in the Internet (*see Column 1, Lines 56-57*) and scripts are used in many different situations and have a wide range of

applications (*see Column 1, Lines 60-61*). One would have been motivated to execute commands against the UDDI registry in order to enable users to quickly, easily, and dynamically find businesses and services on the Internet (*see Paragraph [0004]*).

As per **Claim 14**, Guinart discloses a computer program product comprising instructions which, when executed on a data processing host, cause the data processing host to carry out a method **as in Claim 11 above**. However, Guinart does not explicitly disclose that the sequence of commands is to be executed against a Universal Data Directory Interface (UDDI) registry.

In the same area the problem sought to be solved, Nykanen discloses a method to enable a mobile phone or wireless Personal Digital Assistant (PDA) to discover Internet businesses and services by accessing the Universal Description, Discovery, and Integration (UDDI) registry. The method is embodied as programmed instructions, which may be executed within the user's wireless device to query the UDDI registry. Alternately, the method is embodied as programmed instructions, which may be executed within a separate server to query the UDDI registry in response to commands from the user's wireless device (*see Paragraph [0011]*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to execute commands against the UDDI registry in the system of Guinart since Guinart discloses that scripts are used in the Internet (*see Column 1, Lines 56-57*) and scripts are used in many different situations and have a wide range of applications (*see Column 1, Lines 60-61*). One would have been motivated to execute commands against the UDDI registry in order to enable users to quickly, easily, and dynamically find businesses and services on the Internet (*see Paragraph [0004]*).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. **Mahajan** (US 5,404,528) discloses a scripting system by which the functionality present in an application program may be executed via a script.

B. **Neumann et al.** (US 5,475,811) disclose a system for executing a script sequence containing a plurality of commands and associated time for executing the commands.

C. **Ushiku** (US 5,692,198) discloses a method for executing a process defined in a character string or script in an object in response to a user operation on the object.

D. **McLain, Jr. et al.** (US 5,854,930) disclose a script processing system, method, and computer program product that can automatically perform repetitive operations without requiring separate command records to repeat each operation.

E. **Noda** (US 5,920,717) discloses an automated program-generating apparatus, which has transformation rules describing the relationship between the input specification and the output program internally, and generates the program from the input specification according to the transformation rules.

F. **Apte et al.** (US 6,078,743) disclose a scripting environment in component software architectures and allowing the user to select a scripting language and create a run script in that language within a component software architecture such as Java™.

G. **Jibbe** (US 6,311,320) discloses a scripting tool whose operation and user interface are based upon a definition file.

H. **Liu et al.** (US 6,424,978) disclose a hypermedia authoring tools for creating an electronic file format for card-based hypermedia documents without the knowledge of the target document format using a script-based formatting process.

I. **Hernandez, III** (US 6,658,646) discloses using a scripting language to generate a liaison interface between a user and an existing user interface and includes an integration construct data structure that permits commands from user interfaces to be integrated in a single script.

J. **Wainwright** (US 6,889,374) discloses applications that may execute scripts written in a scripting language that defines instructions corresponding to user input entered through a GUI.

K. **Jameson** (US 6,917,947) discloses a automated software systems for processing collections of computer files in arbitrary ways, thereby improving the productivity of software developers, web media developers, and other humans and computer systems that work with collections of computer files.

L. **Ueno et al.** (US 2003/0217352) disclose a script processing method and apparatus capable of restricting execution of a script program newly entered by a user while another script program is executing on the user's computer.

M. **Opheim et al.** (US 2004/0230327) disclose an improved script generation and usage for handheld field maintenance tools.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Qing Chen whose telephone number is 571-270-1071. The

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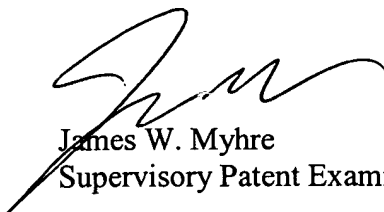
Examiner can normally be reached on Monday through Thursday from 7:30 AM to 4:00 PM.

The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre, can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QC / ac
June 1, 2006



James W. Myhre
Supervisory Patent Examiner